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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,990	12/22/2000	Su-Syin S. Wu	JOHNA.37C1CPI	8376

20995 7590 11/19/2003

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

MCKANE, ELIZABETH L

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/746,990

Applicant(s)

WU ET AL.

Examiner

Leigh McKane

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-12 and 14-18 is/are rejected.
- 7) ☐ Claim(s) 7, 13, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.7.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Claim Objections

1. Claims 11 and 12 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 11 attempts to further limit claim 1 by further limiting the type of fluid to be used. However, claim 1 is an apparatus claim reciting a structure that “*when* fluid is applied thereto, more fluid flows around said projections than through said at least one material of said medical device” (emphasis added). Thus, a fluid is not positively recited in claim 1 and need not be present to meet the limitations of claim 1. Therefore, it is improper to attempt to further limit the type of fluid, since the fluid itself is not a positive limitation of the claim.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 8, 11, 12, 14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Curutchet (U.S. Patent No. 3,393,680).

Curutchet teaches a medical device (forceps) having two pivoting parts 4,5 with at least one contact area therebetween (see Figures 1 and 4), the medical device being made of at least one material and comprising a plurality of projections on the contact area. As

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the device is not made of a porous material, when fluid is applied thereto, more fluid will flow around the projections than through the at least one material of the medical device.

The contact area has regular pointed projections thereon.

4. Claims 1-6, 8, 9, 11, 12, 14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Baumgarten (U.S. Patent No. 3,913,586)

Baumgarten discloses a medical device (hemostat) having two pivoting parts with at least one contact area 9 therebetween (see Figure 2), the medical device being made of at least one material and comprising a plurality of projections on the contact area. As the device is comprised of a polymer over stainless steel and thus, is not made of a porous material, when fluid is applied thereto, more fluid will flow around the projections than through the at least one material of the medical device. The contact area has regular pointed projections thereon.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Curutchet.

Although Curutchet does not disclose a material from which the surgical forceps are fabricated, it is deemed obvious to one of ordinary skill in the art to use stainless steel for the material as it is known for use in surgical instruments as it is non-reactive with body tissues.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumgarten.

The instrument of Baumgarten is fabricated from stainless steel covered with a polymeric material. Although Baumgarten does not specifically teach those polymeric materials recited in the instant claim, it is disclosed that "any of the other polymeric materials which are extrudable" are suitable for use in the invention of Baumgarten. See col.2, lines 60-65. Therefore, it would have been obvious to use other known polymers.

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10. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schad (WO 96/30058) in view of Curutchet.

Schad teaches a method of cleaning and disinfecting surgical forceps within a chamber, wherein the forceps are contacted with a cleaning/disinfecting fluid while being moved. Although Schad does not disclose that the forceps have a plurality of projections on a contact area, Curutchet evidences that this is the common configuration found in surgical forceps. See Figure 4 of Curutchet. Therefore, it would have been obvious to employ the method of Schad to clean and disinfect surgical forceps having a contact area and projections on the contact area.

Allowable Subject Matter

11. Claims 7, 13, 19, and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter: Neither Curutchet nor Baumgarten teach a connector housing or luer lock having the limitations of claim 1. Moreover, the projections disclosed by both Curutchet and Baumgarten are regular, not random. In the method of Schad, the fluid is not circulated within the chamber nor is the pressure reduced.

Conclusion

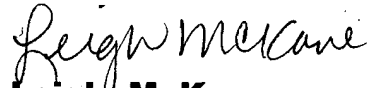
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leigh McKane whose telephone number is 703-305-3387

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until December 15, 2003. After December 15, 2003 the examiner can be reached at 571-272-1275. The examiner can normally be reached on Monday-Wednesday (7:15 am-4:45 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Warden can be reached on 703-308-2920 or at 571-272-1281 after December 15, 2003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Leigh McKane
Primary Examiner
Art Unit 1744

elm
3 November 2003